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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,907	10/23/2003	Robert Galli	P00573-US2	6537
3017	7590	07/12/2005	EXAMINER	
BARLOW, JOSEPHS & HOLMES, LTD. 101 DYER STREET 5TH FLOOR PROVIDENCE, RI 02903			CHOI, JACOB Y	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/691,907	GALLI, ROBERT
	Examiner Jacob Y. Choi	Art Unit 2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 July 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1-4 and 17-19 is/are allowed.
- 6) Claim(s) 5,6,11 and 12 is/are rejected.
- 7) Claim(s) 7-10 & 13-16 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 05 July 2005 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 5, 6, 11 & 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee (USPN 6,334,693).

Regarding claim 5, Lee discloses a housing (10) having a primary compartment (15), the primary compartment being configured to receive a primary tool (37), the housing including a front end (17), a back end (opposite end of the front) and a top surface (Figure 1), and a channel (15) forming a secondary compartment (rear end) in the housing proximate to the back end of the housing, proximate to the back end of the housing, the channel having a bottom wall and a side wall extending upwardly between the bottom wall and the top surface with an opening in the side wall at the back end of the housing, the channel having mating formations adapted to slideably receive a secondary tool (flash light) through the opening in the side wall.

Note: claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Regarding claim 6, Lee discloses a closure element (36) pivotably connected to the back end of the housing, the closure element being pivotably from a first open position to a second closed position over the opening in the sidewall wherein the closure element in the closed position retains the secondary tool in the channel.

Regarding claim 11, Lee discloses an outer casing (10) for enclosing primary device, the outer casing having a front end (17), a back end and a top surface (Figure 1), and a channel forming a secondary compartment (15) in the outer casing proximate to the back end of the housing (opposite end of the front), the channel having a bottom wall and a side wall extending upwardly between the bottom wall and the top surface (Figure 1) with an opening in the side wall at the back end of the housing, the channel having mating formations adapted to slideably receive a secondary tool through the opening in the side wall.

Regarding claim 12, Lee discloses a closure element (36) pivotably connected to the back end of the housing, the closure element being pivotably from a first open position to a second closed position over the opening in the sidewall wherein the closure element in the closed position retains the secondary tool in the channel.

Response to Amendment

3. The examiner acknowledges that the applicant has amended specification, paragraph 12, to over come objection to drawings and rejection of claim under 35 USC 112. Applicant also filed "Terminal Disclaimer" against statutory double patenting rejection and stated that the present application and the cited USPN 6,663,257 are commonly invented and owned. No amendments to the claims have been made.

Response to Arguments

4. Applicant's arguments filed 7/5/2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the rear portion of the housing, the pocketknife, a small opening is required and a much smaller closure element is necessary to retain the tool in the housing) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Note: claims 11 and 12 recites utilizes term such as "proximate to said back end" and "adapted to". Claims in a pending application should be given their broadest reasonable interpretation.

Allowable Subject Matter

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5. Claims 7-10 and 13-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter:

Claim 1, recites a housing having a channel configured within the top surface and extending inwardly from a peripheral edge of the back end of the housing, the channel having a bottom wall and opposing side walls extending upwardly from the bottom wall, and further having an opening in the side wall *at the back end* of the housing, the channel being configured to slideably receive a removable tool, the channel and the removable tool having complementary formations for interfitting engagement thereof, and a closure element movably coupled to the back end of the housing.

Claim 17 recites a secondary compartment having a front end, a back end, a top surface, and a channel configured within the top surface, the secondary compartment being configured to slideably receive the pocket knife in interfitting mated relation therein & the secondary compartment and the pocket knife having complementary formations for interfitting engagement thereof.

Lee (USPN 6,334,693) teaches wrench / casing having channels & a closure element for a portable flashlight.

Because none of the reference cited discloses the combination of a case / housing assembly having both primary compartment and a secondary compartment /

channel where secondary compartment / channel is configured to slideably receive the pocket-knife / removable tool in interfitting mated relation & the casing comprising a closure element removably coupled to *the back end* of the housing proving an open and close operation, nor is there any motivation to combine them, the claims are deemed patentable over the prior art of record. Claims 1-4 and 17-19 are allowed.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Y. Choi whose telephone number is (571) 272-2367. The examiner can normally be reached on Monday-Friday (10:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JC



THOMAS M. SEMBER
PRIMARY EXAMINER